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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------|------------------|
| 10/644,686 | 08/19/2003 | Tomoaki Koseki | P-PET1 | 6728 |
| 7590 | 04/04/2005 | | EXAMINER | |
| Tomoaki Koseki 17-2, Sotokanda 2-chome Chiyoda-ku Tokyo, 101-0021 JAPAN | | | GEHMAN, BRYON P | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3728 | |
| | | | DATE MAILED: 04/04/2005 | |

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/644,686 | KOSEKI, TOMOAKI | |
| | Examiner | Art Unit | |
| | Bryon P. Gehman | 3728 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 14 February 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 8-28 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-7 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/19/03.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

1. Applicant's election of the invention set forth by claims 1-7 in the paper filed February 14, 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 8-28 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions and species, there being at this time no allowable generic or linking claim.

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed hinge structure of claims 3 and 4 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not

described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It is indefinite and unclear what is encompassed by claim 4, as it is incomprehensible as written.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are not in idiomatic English. In line 1 of each claim, "hinge processed goods" is ungrammatical.

In claim 1, line 5, "parts...is" is ungrammatical.

In claim 3, line 3, "the peak line" lacks antecedent basis.

In claim 4, line 2, "a circular form rolling a flat plate" does not make any sense.

In claims 6 and 7, lines 4 and 3-4 and 7, respectively, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10

USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 6 and 7 each recite the broad recitation "sheets", and the claim also recites "such as sterilized paper, film or Tyvek", which is the narrower statement of the range/limitation.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Rider et al. (5,413,239). Rider Jr. discloses providing a hinged processed good from PET wherein the thinnest part of the hinge is more than 0.2 mm (about 0.008 inches)(see column 2, line 63 through column 4, line 59) and parts connected to the hinge are thicker (see Figures 2, 4, 6 and 7).

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over either one of JP 2003-48967 and JP 2003-64167 in view of Rider Jr.. The two Japanese references are disclosed by applicant to disclose PET resin raw material with improved fluidity, higher transparency and stronger shockproof property modified with co-polymerization and compound technology. Rider Jr. discloses providing a hinged processed good from PET wherein the thinnest part of the hinge is more than 0.2 mm (about 0.008 inches)(see column 2, line 63 through column 4, line 59) and parts connected to the hinge are thicker(see Figures 2, 4, 6 and 7).

11. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over either one of JP 2003-48967 and JP 2003-64167 in view of Friedman (5,865,307). The two Japanese references are disclosed by applicant to disclose PET resin raw material with improved fluidity, higher transparency and stronger shockproof property modified with co-polymerization and compound technology. Friedman discloses providing a hinged processed good from thermoplastic wherein the thinnest part of the hinge is more than 0.2 mm (about 0.008 inches)(see column 4, line 30 through line 52) and parts connected to the hinge are thicker (see Figures 2b and 3).

As to claim 4, the manner of making the hinge fails to distinguish any difference in structure.

12. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 1, 2, 3 or 4 above, and further in view of Fischer (5,031,768). Fischer discloses a hinged thermoplastic container provided for to pack disposable medical apparatus. To employ the hinged container of the prior art for disposable medical apparatus would have been obvious in view of Fischer, as it was known to provide hinged thermoplastic containers for disposable medical apparatus.

13. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 5 above, and further in view of Paikoff et al. (4,523,679). To employ a heat sealed wrap about the container of the previous combination would have been obvious in view of Paikoff et al. in order to maintain the container in a sterile condition.

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shown are hinged containers and containers made from PET.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryon P. Gehman whose telephone number is (571)

272-4555. The examiner can normally be reached on Monday through Wednesday from 5:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-4555.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Bryon P. Gehman
Primary Examiner
Art Unit 3728

BPG